

### REMARKS

Reconsideration of the present application in view of the above amendments and following remarks is respectfully requested. After entry of this amendment, claims 1 to 16, 18 to 32, 45 to 47, 50 to 59 and 77 to 93 are pending. Claims 1, 18, and 45 have been amended. Claims 17, 33 to 44, 48, and 49 have been cancelled, without prejudice, and no claims have been added.

The Office Action includes an affirmation of the Restriction Requirement, as well as rejections under Section 102 which are addressed below.

#### Discussion of the Restriction Requirement

Applicants respectfully submit that the affirmation of the Restriction Requirement<sup>1,2</sup> and the withdrawal from further consideration of method of use claims 50 to 59 and 77 to 93 are improper.<sup>3</sup> Nevertheless, to facilitate prosecution of the present application, applicants have amended the claims to conform with the restriction requirement. In particular, independent claim 1 has been amended by replacing generic formula I with generic formula II, and the definitions for various chemical moieties have been revised. In addition, compound claims 17 and 33 to 44 and pharmaceutical composition claims 48 and 49 have been canceled.

Applicants note that claims 50 to 59 and 77 to 93 have been withdrawn from further consideration as being directed to non-elected subject matter. It is applicants' understanding

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<sup>1</sup> Applicants acknowledge that the Restriction Requirement has been modified in the present Office Action in that claims 33 to 35, which define compounds of formula I wherein R<sup>2</sup> and R<sup>3</sup> and the carbon atoms to which they are attached form a fused carbocycle (but not necessarily to provide compounds of formula IV as indicated in the Office Action), have been moved to Group II.

<sup>2</sup> Applicants have observed that the original Restriction Requirement included a typographical error in that Group VIII (originally corresponding to claim 64 and rewritten in applicants' Reply dated May 2, 2005 as claim 84) and Group IX (originally corresponding to claim 67 and rewritten in applicants' May 2 Reply as claim 87) are both identified as being drawn to methods of preventing or treating obesity. However, original claim 64 (now claim 84) defines methods of preventing or treating gastrointestinal dysfunction, and original claim 67 (now claim 87) defines methods of preventing or treating obesity.

<sup>3</sup> It is applicant's understanding that claims 77 to 93 have been grouped in the Restriction Requirement in the same manner as with original claims 60 to 76.

that these claims will be rejoined to the extent that patentable subject matter is identified in the composition of matter claim from which they depend.

Applicants hereby affirm the right to file one or more divisional applications directed to any of the non-elected subject matter.

### Discussion of the Rejections Under 35 U.S.C. §102

The art rejections are addressed in the order they appear in the Office Action.

#### Jacobson and Aceto

Claims 1 to 7, 14 to 23, and 45 to 47 stand rejected under U.S.C. §102 (b) as allegedly being anticipated by Jacobson (CA 125:185591) or Aceto (CA 125:185593). Each of Jacobson and Aceto describes the same compound, *anti*-3-(2,9-dimethyl-2-azabicyclo-[3.3.1]non-5-ylphenol, represented by CAS Registry Number 88550-29-2.

Applicants respectfully disagree with this rejection, and submit that the claims, as originally presented to the Patent Office, define over the Jacobson and Aceto references and the CAS Registry compound. In this regard, the CAS Registry compound from Jacobson and Aceto includes a phenol moiety linked to a piperidine ring, in which the piperidine nitrogen atom is necessarily substituted with a methyl group. In contrast, Applicants' original independent claim 1 includes the proviso that when R<sup>1</sup> is -OH, then W is heterocycloalkyl, alkylheterocycloalkyl, -CH<sub>2</sub>OH, or -C(=O)R<sup>10</sup>. In other words, when R<sup>1</sup> in applicants' compounds is -OH, then W is other than hydrogen, and R<sup>6</sup> therefore cannot be methyl, as is the corresponding substituent in the Jacobson, Aceto, and CAS Registry compound. It is submitted respectfully that there is no disclosure or suggestion in Jacobson or Aceto of compounds as defined in independent claim 1.

In view of the foregoing discussion, reconsideration and withdrawal of the rejection based on Jacobson, Aceto and/or the CAS Registry are respectfully requested.

#### Thomas

Claims 1 to 9, 14 to 26, and 45 to 47 stand rejected under U.S.C. §102 (b) as allegedly being anticipated by Thomas (Tetrahedron Letters and J. Med. Chem.). It is basically

asserted in the Office Action that the cited documents teach compounds that are encompassed within the present claims.

As with Jacobson and Aceto, discussed *supra*, applicants respectfully submit that the claims, as originally presented to the Patent Office, define over the Tetrahedron Letters and J. Med. Chem. documents. In this regard, the formula 3 compounds disclosed in the Tetrahedron Letters document represent a genus wherein the substituent R (which corresponds to element R<sup>6</sup> of applicants' claims) is an alkyl group attached to the piperidine nitrogen atom. The J. Med. Chem. document discloses, *inter alia*, the compound of formula 5c which has the same structure as the formula 3 compound in Tetrahedron Letters except that the piperidine nitrogen atom is substituted with a phenethyl group rather than an alkyl group. As noted hereinabove, applicants' claims require that when R<sup>1</sup> is OH, W is other than hydrogen, and therefore R<sup>6</sup> is other than alkyl. By virtue of this same proviso, when R<sup>1</sup> is OH, W is other than aryl, and R<sup>6</sup> therefore is other than phenethyl. Accordingly, it is submitted respectfully that there is no disclosure or suggestion in the cited Tetrahedron Letters or J. Med. Chem. documents of compounds as defined in the present claims.

In view of the foregoing discussion, reconsideration and withdrawal of the rejection based on Thomas (Tetrahedron Letters and J. Med. Chem.) are respectfully requested.

#### **Carroll**

Claims 1 to 9, 14 to 26, and 45 to 47 stand rejected under U.S.C. §102 (b) as allegedly being anticipated by Carroll (US 6,531,481), particularly with regard to compounds set forth in claims 1 to 9. As with the other cited art, it is submitted that applicants' original claims define over the Carroll patent.

In this regard, Carroll discloses compounds where the substituent connected to the piperidine nitrogen atom is alkyl or aralkyl. For the reasons proffered hereinabove, the piperidine nitrogen in the compounds defined in the present claims is substituted with groups other than alkyl or aralkyl groups when R<sup>1</sup> is OH. There is no disclosure or suggestion in Carroll of compounds as defined in the present claims.

In view of the foregoing discussion, reconsideration and withdrawal of the rejection based on Carroll are respectfully requested.

**DOCKET NO.:** ADOL-0712  
**Application No.:** 10/798,664  
**Office Action Dated:** August 10, 2005

**PATENT**

**Miscellaneous**

Applicants acknowledge the Examiner's indication that claims 10 to 13 and 27 to 32 are free of the prior art, and would be allowable if rewritten in independent form to include all of the recitations of the base claim and any intervening claims from which they depend. Applicants appreciate the Examiner's willingness to allow these dependent claims. However, in view of the above amendments and remarks, it is submitted respectfully that it is unnecessary to place these claims into independent form at this time.

**Conclusion**

Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejections and an allowance of all of pending 1 to 32, 45 to 47, 50 to 59 and 77 to 93 are requested respectfully.

Date: December 8, 2005

  
Walter C. Frank  
Registration No. 52,911

Woodcock Washburn LLP  
One Liberty Place - 46th Floor  
Philadelphia PA 19103  
Telephone: (215) 568-3100  
Facsimile: (215) 568-3439